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In re Application of
SOULES, et al.
Serial No.: 10/525,697
PCT No.: PCT/US03/27363
Int. Filing Date: 29 August 2003
Priority Date: 30 August 2002
Atty Docket No.: GLOZ 2 00122
For: COATED LED WITH IMPROVED EFFICIENCY :

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to the "Petition to File Other Than All The Inventors Under 37 C.F.R. §1.47(a)" filed 23 March 2006 in the United States Patent and Trademark Office (USPTO) to accept the application without the signature of joint inventor Chen-Lun Hsing Chen. Applicant has authorized charging of the \$200.00 petition fee to deposit account number 06-0308.

BACKGROUND

On 29 August 2003, applicant filed international application PCT/US03/27363 which claimed priority to a previous application filed 30 August 2002. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 30 February 2005.

On 22 February 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a preliminary amendment and an Information Disclosure Statement.

On 19 September 2005, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 23 March 2006, applicant filed the present petition under 37 CFR 1.47(a) accompanied by a petition for a four-month extension of time. With payment of the four-month extension of time and certification under 37 CFR 1.8, applicant's present response is considered timely filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items 1 and 3.

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts." The statement of facts from counsel does not satisfy this item. Mr. McCollister states that on two occasions the non-signing inventor was contacted by e-mail to execute the declaration. Applicant has not included copies of the e-mails in question nor proof of delivery. In addition, applicant has not included any information to indicate the e-mail address used to contact inventor Chen is a valid e-mail address. Lastly, Mr. McCollister does not detail whether he has firsthand knowledge of the e-mail attempts and whether these emails included attachments comprising a complete set of application papers for the inventor's review.

While the statement of facts indicates that the inventor requested communication by e-mail, a successful petition under 37 CFR 1.47 is more easily accomplished when a complete set of application papers is mailed to the last known address of the inventor and the subject inventor either refuses to execute the declaration or does not respond.

Regarding item (4), the filed declaration does not comply with 37 CFR 1.497 (a)-(b). Specifically, MPEP Section 201.03 states that:

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.

The filed declaration contains two pages "3 of 5" and two pages "5 of 5." This suggests that either the filed declaration was compiled from numerous declarations or that the inventors only returned their signature pages. Either scenario renders the document non-compliant.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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